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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/623,181	12/12/2000	John Edward Andrew Shaw	20-954	9642

7590

02/13/2003

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EXAMINER

ALEXANDER, LYLE

ART UNIT

PAPER NUMBER

1743

DATE MAILED: 02/13/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/623,181

Applicant(s)

SHAW, JOHN EDWARD ANDREW

Examiner

Lyle A Alexander

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 26 November 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-48 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-48 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

***Claim Rejections - 35 USC § 102***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-8, 10-33 and 36-48 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Burns et al. (USP 6,379,929).

See the appropriate paragraph of paper 7.

Claims 1-7, 12, 18-31, 34, 36-43 and 45-58 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Gubinski et al.

See the appropriate paragraph of paper 7.

***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 9 and 34-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Burns et al. in view of Jones.

See the appropriate paragraph of paper 7.

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gubinski et al. in view of Jones.

See the appropriate paragraph of paper 7.

Claim 35 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gubinski.

See the appropriate paragraph of paper 7.

***Response to Arguments***

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Applicant's arguments filed 11/26/02 have been fully considered but they are not persuasive.

Applicant states Burns fails to teach the claimed "channels" and the deformable material that is unconnected to the walls/capillaries of the device. The Office maintains Burns teaches channels through which fluid is transferred which has been properly read on the instant claims. The second point that claims require the swellable material to be disconnected from the walls/capillaries of the device is not commensurate in scope with the claims (e.g. no limitations exist that require this structure).

Applicants traverse the combination of Burns in view of Jones. Applicant states Jones teach the elastomeric element completely filling the channel and possible deformed by "physical force". The Office maintains the claim language is not specific enough to exclude the teachings of Jones. Additionally, the "release" of Jones has been read on the claimed "pressure".

Applicant traverse the rejection of claim 9 and 35 over Gubinski stating the expandable polymer never occupies an "intermediate position" and cannot be "reused". The instant claim language requires a "change of the rate of fluid flow" which is met by Gubinski and there are no limitations to "reusability" of the device.

The Office notes Applicant has not traversed the 35 USC 102(b) rejections of 1-7,12,18-31,34,36-43 and 45-58 as being clearly anticipated by Gubinski et al.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. May et al.(USP 5,275,785), Patel et al.(USP 5,260,222), Kurn et

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al.(USP 5,104,812) and Sizto et al. (USP 5,620,657) all teach a liquid swellable materials that regulates the fluid flow through test devices.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lyle A Alexander whose telephone number is 703-308-3893. The examiner can normally be reached on Monday, Wednesday and Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on 703-308-4037. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9319 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0651.

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Lyle A Alexander  
Primary Examiner  
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February 10, 2003

A handwritten signature in black ink, appearing to read 'Lyle A. Alexander'.